

REMARKS

The Office Action dated October 3, 2003, and the references cited therein have been carefully considered. The applicant appreciates that the Examiner reviewed the pending claims 82-100 even though the amendment incorrectly labeled them as being previously added rather than new. In addition, the applicant appreciates the Examiner bringing to the applicant's attention that the previous amendments to the specification and the abstract were not entered. Accordingly, the same amendments are included.

Under relevant case law and according to MPEP section 2143.01, a suggestion or motivation is needed to modify a reference under 35 U.S.C. Sec. 103 in order meet the requirements of a prima facie section 103 rejection. None of the stated rejections identify a legally cognizable suggestion for combining the cited references, and all of those same rejections fail to cite actual evidence to support the positions taken in the previous Office action. As explained in detail below the role of the Patent Office is narrowly restricted to examining the prior art for actual evidence of obviousness of the claimed combinations. Absent actual evidence, the rejections collapse.

The bedrock legal principles for rejecting a claim under 35 U.S.C. § 103 demonstrate the problematic nature of the rejections. Specifically, in In re Rouffet, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) the Federal Circuit explained: "To reject claims in an application under section 103, an examiner must show an un rebutted prima facie case of obviousness. In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent." Id. at 1455 (citations omitted and emphasis added). In the Rouffet case, the Examiner had rejected the pending claims on a combination of references. The Board sustained the Examiner. However, the Federal Circuit reversed the Board's decision and ruled that the Examiner's rejections were legally

impermissible because they failed to demonstrate a suggestion for combining the references in the manner proposed by the Examiner.

As explained by the Federal Circuit:

As this court has stated, “virtually all [inventions] are combinations of old elements.” Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to **show** a motivation to combine the references that create the case of obviousness.

Id. at 1457-58 (citations omitted and emphasis added). These principles have not been followed in rejecting the pending claims. Merely stating an advantage or possible advantage of combining references, as was done to reject the pending claims, is not the same as “show[ing] a motivation to combine the references.”

On the contrary, in order to establish a prima facie case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In order to establish a prima facie case of unpatentability, particular factual findings demonstrating the suggestion to combine must be made. See, for example, Ecolochem Inc. v. Southern California Edison, 56 U.S.P.Q.2d 1065, 1072-73 (Fed. Cir. 2000) and In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617-1618 (Fed. Cir. 1999). Indeed, the law is quite clear that an obviousness rejection must be based on facts, not conjecture.

The Supreme Court... foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal

conclusion of obviousness *must be supported by facts*. Where the legal conclusion is not supported by facts it cannot stand.

In re Warner, 379 F.2d 1011, 1017 (C.C.P.A. 1967). This longstanding principle has been followed to date. For example, in the unpublished Board decision, Ex parte Megens, App. No. 1999-0277 (B.P.A.I. Oct. 29, 1999), the Board stated:

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 U.S.P.Q. 173, 177-78 (CCPA 1967). *In making such a rejection, an examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.*

The examiner's conclusion that it would have been obvious to incline Phillips' loading dock floor 65 rests on the completely unfounded assumption that it would be desirable to drain liquid from the floor. The Phillips reference, however, is devoid of any indication that liquid might accumulate on the floor or that such accumulation would pose a problem even if it did occur. It is therefore apparent *that the examiner has resorted to improper speculation* and hindsight reconstruction to overcome the admitted deficiency of Phillips vis-à-vis the subject matter recited in claim 1.

(Megens at Pages 4-5)(emphasis added).

This is precisely the situation presented in this application. The § 103 rejections made in the Office action amount to statements that, given the alleged presence of these elements in the prior art and the advantage that combining these elements would allegedly achieve, a person skilled in the art would have found it obvious to combine the references to create the claimed invention. The problem with this approach is that it *effectively eliminates the requirement of identifying a suggestion for combining references from the obviousness analysis*. More specifically, the analysis present in the Office action proceeds in the following manner:

- a) What elements are present in the pending claims?
- b) Can these elements be found in prior art references?

c) If they can be found, and the references themselves provide no suggestion for combining these elements, can some end or advantage be identified to combine the elements in the manner proposed in the Applicant's claims?

d) If so, combine the elements in the manner proposed by the Applicant and reject the pending claims.

This analysis is flawed. Specifically, as noted by the Federal Circuit in the Rouffet quote identified above, all of the elements of most claimed inventions can almost always be found in the prior art. Therefore, the answer to step “b” above will almost always be “yes.” Since it is a statutory requirement that all inventions have utility, there will also always be an identifiable end or advantage in combining the elements in the prior art in the manner proposed by any claim (e.g., if there was no purpose to an element in a claim it would not be included in the claimed apparatus, after all, who would pursue a claim with superfluous elements or a claim with no utility?). Therefore, if the “suggestion” requirement of 35 U.S.C. § 103 can be met by merely identifying any end or advantage which will be achieved by combining the elements of the prior art references, the suggestion requirement can always be met and is meaningless.

This inherent flaw in the analysis employed in the Office action is elucidated by viewing an example of its use. On page 4, the Office action states:

It would have been obvious to one skilled in the art at the time of the invention to modify the Vancura teachings to have the machine 'electronically select' one of the answers to the knowledge based game after a brief period of time, in order to ensure a reasonable play rate.

(Office Action dated October 3, 2003, Page 5). Examining the “motivation” statement more carefully, the first part of the statement, namely, “It would have been obvious to one skilled in the art at the time of the invention modify the Vancura teachings to have the machine 'electronically select' one of the answers to the knowledge based game after a brief period of

time" simply states what the proposed modification of the primary reference is to be; in this case modifying the Vancura reference to include the random element of Brossard after a period of time. This part of the statement, thus, describes the proposed modification, but offers no explanation of a motivation for making that modification. The final part of the statement, namely, "in order to ensure a reasonable play rate" must, then be the alleged "motivation" for modifying Vancura.

However, while it is true that one possible advantage of ensuring a reasonable play rate, that is not a suggestion in and of itself for adding random selection from Broussard to Vancura. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious **unless the prior art suggested the desirability of the modification.**" In re Fritch, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992)(emphasis added). Here, the Office action does not identify anything in the prior art that suggests the desirability of the modification because there is no mention in Vancura of maintaining a rate of play. The rejection only identifies an old element (i.e., random choice after a period of time) that has several inherent properties, including rate of play control. Indeed, the Office action's conclusory statement amounts to nothing more than stating "A person of ordinary skill in the art would be motivated to modify Vancura to include random selection after a period of time because they would want to gain a benefit of having play rate control." In other words, the Examiner is effectively saying that the motivation of adding random choice after a period of time to Vancura is to have the inherent benefit of adding control of the rate of play to Vancura. Of course, such circular reasoning (i.e., add "X" to have "X") cannot be a legally proper tool for identifying a suggestion for combining references. If it were, no combination of old elements would ever be patentable because one can always state, a person would be motivated to add old element X from one reference to another reference because adding element X offers an advantage (again, if adding "X" had no

advantage, who would ever claim it?). Simply put, there is always an advantage to combining old elements that can be identified once that combination is known.

It should be quite clear from the above that merely identifying an advantage for adding an old element to a combination of elements is not a proper suggestion for making that combination. The MPEP further proves this point. In particular, MPEP § 2144 states that “the strongest rationale for combining references is a recognition . . . in the prior art or . . . based on established scientific principles or legal precedent, that some advantage would have been produced by their combination.” The MPEP cites In re Sernaker, 702 F.2d 989, 994-95 (Fed. Cir. 1983) to support this proposition.

Looking first at the Sernaker case, the Federal Circuit states: “The lesson of this case appears to be that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.” Sernaker, 702 F.2d at 995-96 (emphasis added). Notice that this statement does not state that it is obvious to combine references simply because there is an advantage to doing so. On the contrary, it carefully states that there can be no obviousness ruling unless something in the art suggests an advantage to combining the references. The advantage itself is not the suggestion, but rather the Court makes it clear that something else suggests the advantage.

The MPEP quote noted above is similar. It states that the “strongest rationale for combining references is a recognition . . . in the prior art or . . . based on established scientific principles or legal precedent that some advantage or expected beneficial result would have been produced by their combination.” (MPEP, Page 2100-127) (emphasis added). This, of course, does not state that the strongest rationale for combining references is the mere presence of an advantage to doing so. Instead, as in Sernaker, the strongest rationale is a recognition (i.e., a suggestion) in the art that an advantage will result.

Without looking for something in the art that suggests an advantage to making the combination, the suggestion requirement is literally eliminated¹. As there is always an advantage to a claimed element (or why would you claim it?), the Office action's view of an advantage as the suggestion inherently renders all combinations of old elements unpatentable precisely because it eliminates the suggestion requirement from the analysis. Clearly, neither the MPEP section noted above nor the Sernaker case upon which that MPEP section rests for authority stands for the proposition that an advantage of an element is a suggestion in and of itself for including that element in a combination.

In view of the foregoing, applicants respectfully submit that the § 103 rejections made in the Office action must be withdrawn because they fail to identify a legally proper suggestion for combining the prior art references in the manner proposed by the Examiner. There is no motivation or suggestion in Vancura to add a random selection feature in order to control the rate of play.

Vancura Teaches Away From Brossard

Turning to the specifics of the § 103 rejection, the Office Action proposes a combination of the Vancura and Brossard references as a basis to reject all the claims. Vancura teaches away from Broussard, making the combination improper. MPEP Section 2141.02 states that prior art must be considered in its entirety, including disclosures that teach away from the claims. Specifically, "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

In relevant part, Vancura states:

¹ It literally removes the "recognition" portion of the MPEP quote above and the "something in the art" portion of the Sernaker quote.

Having the opportunity to **test a player's knowledge** of trivia, facts, surveys, pricing, and so forth **independent of a player's skill in a game of chance** would be a welcome addition to the casino experience.

Vancura, page 1, paragraph 8 (bold added). Vancura apparently is concerned with adding player skill to a casino game to give the player the illusion that the player has some control over the game. Apparently, the overriding idea behind Vancura is to eliminate chance from the game and allow players to control the game based on their skill and knowledge. For example, in Vancura, apparently a question is asked and it is up to the player to select the correct answer even if it takes a significant amount of time for the player to answer. The element of chance apparently is purposely removed from Vancura. For example, a player with perfect knowledge may obtain a 0 percent return from the game where a player with no knowledge may obtain a -8 percent return. Vancura discloses a range of payoffs and the player's payoff, while in the specified range, is related to the knowledge of the player with the idea being that a player with perfect knowledge should not be able to win excessively and a player with no knowledge should not be permitted to lose excessively.

IS A PLAYER WITH NO KNOWLEDGE THE SAME A RANDOM EVENT?

In previous Office actions, the Examiner stated that Vancura contemplates a player with no knowledge. According to the Examiner, a player with no knowledge is the same as a random event. As such, the Examiner argues that Vancura is teaching toward the random answer disclosed in Brossard, not away as argued by the Applicant.

There are several key distinctions between a player with no knowledge and a random event. A player with no knowledge may only have no knowledge on a single question. On subsequent questions, the player may have knowledge, meaning the player no longer has a random chance of selecting the correct answer.

In addition, even a player with no knowledge has to make choice. A player with no knowledge could simple choose 'Answer A' every time. This is a choice. Selecting the

correct answer may be a random event but the actual selection of an answer is not random, but a choice made by the player. The player at least has the illusion of control by selecting the answer, even if the probability of selecting a correct answer may be random.

Moreover, as the player with no knowledge still has control, the player controls the timing of the game. Even assuming that a player with no knowledge is the functional equivalent of a random event, the player still decides **when** to randomly select an answer. This may seem trivial, but to the player of the game, being able to actively participate in the game enhances the illusion that the player has control of the outcome of the game.

Finally, again assuming that a player with no knowledge is the functional equivalent of a random event, then Vancura has already contemplated a random answer option and does not indicate any motivation or suggestion to add the rate of play control of Brossard. There is a critical leap in logic to make from saying "Vancura discloses random choices" to "Vancura discloses random choices made in a certain period of time." Even assuming that such a leap would be obvious as the Examiner argues, **Vancura purposely taught away** from this logic leap because such a leap would be in conflict with the teachings of allowing the player to have the illusion that his/her knowledge is controlling the game.

As Vancura desires to create the illusion that a player has some control over the outcome, Vancura allows the player to take his/her time and make a selection. By having the gaming machine make a random selection in a certain period of time as apparently disclosed in a Vancura/Brossard combination, the illusion of control would be lost on the player and the purpose of Vancura would be lost. Vancura apparently teaches allowing a person with no knowledge to have the illusion of controlling their own destiny in their own time even to the point where Vancura will ensure the person with no knowledge will not lose an excessive amount of money where Brossard apparently is not concerned with allowing the person to

have the illusion of control by making a choice for the player in a fixed amount of time and allowing the player to lose an infinite amount of money if that is the random result.

Pursuant to the MPEP, as Vancura teaches away from Brossard, it is improper to combine Vancura and Brossard. Therefore, the rejection of the pending claims based on the combination of Vancura and Brossard is improper and the claims should be allowed.

Modified Vancura Would Not Be Fit For Its Intended Purpose

The proposed modification to Vancura by combining it with the "randomly selected answer in a period of time" disclosed in Brossard would render Vancura unsatisfactory for its intended purpose. As MPEP 2143.01 states, the proposed modification cannot render the prior art unsatisfactory for its intended purpose :

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).²

Vancura is concerned with allowing a players knowledge and skill to dictate the outcome of the game. Adding the random select of Brossard to Vancura would result in a device that would not be fit for its explicitly stated intended purpose of allowing the skill and knowledge of the player determine the outcome of the game as a player's knowledge as skill would no longer be the determining factor of whether a player would win at a game.

²Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were prima facie obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.

The Examiner would argue that a person with no skill is a random event, meaning Vancura contemplated random events. Vancura contemplates players with a variety of knowledge and the result to the player is based on that knowledge, even if the player has no knowledge. In Brossard, the random event has a random result even if the player has perfect knowledge, meaning the player has no control over the outcome. Accordingly, Vancura modified by Brossard would not be fit for its intended purpose of allowing a player the illusion of controlling their own destiny by making selections (even if the selections are made with no knowledge), meaning there is no suggestion or motivation to make the proposed modification.

Modifying Vancura Would Improperly Change Its Principle of Operation

MPEP 2143.01 states the proposed modification cannot change the principle of operation of a reference. A principle of Vancura is that the illusion should be created that the player's skill and knowledge determine the outcome of the game. Modifying Vancura by adding the random answer selection in a fixed period of time from Brossard would change the stated principle of operation as the illusion that the player had control of the outcome in Vancura would be lost. Even a player with no knowledge in Vancura has to make a choice, even if the choice is a guess, but the player maintains control of the selection. A random selection makes it obvious to the player that he/she is not controlling the game. Accordingly, such a modification is improper. As MPEP 2143.01 states in relevant part:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to

render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959).³

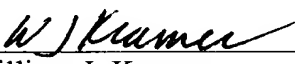
As explained previously, as the proposed combination of the prior art changes the principle of operation of Vancura from giving the player the illusion of control of the game to being solely chance based. Changing the principle of operation indicates that the teachings of Vancura and Brossard are not sufficient to render the claims prima facie obvious.

In conclusion, the applicant respectfully submits that all pending claims are novel and non-obvious and are in condition for allowance. In the light of the foregoing, the prompt issuance of a notice of allowance is respectfully solicited. Should the Examiner have any questions, she is respectfully invited to telephone the undersigned.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-6300

By:



William J. Kramer
Registration No. 46,229
Attorney for Applicant

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³Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 U.S.P.Q. at 352.